



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,906	02/26/2004	William J. Brown	1614CIP	8921

7590 10/01/2004

Mark C. Jacobs, Esq.
3033 El Camino Avenue
Sacramento, CA 95821-6014

EXAMINER

KING, ANITA M

ART UNIT PAPER NUMBER

3632

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,906

Applicant(s)

BROWN, WILLIAM J.

Examiner

Anita M. King

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

This is the first office action for application number 10/789,906, Table Mounted Forearm Edge Rest, filed on February 26, 2004.

Drawings

The drawings are objected to because reference number "23" does not have a lead line, see MPEP 608.02 and reference number "14" in Fig. 6 appears to be incorrect and should be --12--. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: on page 4, line 9, "23" appears to be incorrect and should be --16-- and "ABS" on page 4, line 19 should be spelled out initially.

Appropriate correction is required.

Claim Objections

Claims 1, 2, and 5 are objected to because of the following informalities: in claim 1, line 2, --the-- should be inserted before "channel," and in line 5, "being inserted" should be deleted; in claim 2, line 1 --of the channel-- should be inserted after "plastic"; and in claim 5, line 4, "which" should be changed to --wherein the--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4, 6, 7, 8, 11, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the wrap" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitations "the distal end" in line 1, "the arm's opening" bridging lines 1-2, and "the U" in line 2. There is insufficient antecedent basis for these limitations in the claim.

Claim 6 recites the limitations "the opening" in line 1, "the open end" in line 1, and "the U channel" in line 1. There is insufficient antecedent basis for these limitations in the claim.

Claim 7 recites the limitations "the elevation" in line 4 and "the junction" in line 5. There is insufficient antecedent basis for these limitations in the claim.

Claim 14 recites the limitation "the front elevation" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,554,039 to James. James discloses a edge mountable tilted U-shaped device (10) capable of mounting on an edge of a table, the device formed from a channel of plastic, having two spaces arms (11) extending from a base with a slot therebetween which the channel is exteriorly covered only with a wrap layer of padding (12); the device adapted to snugly fit over the edge of a table; and wherein the elevation of the

Art Unit: 3632

slot at the distal end of the arm's opening at the front is narrower than the elevation of the slot at the base of the channel to provide a snug fit over a edge (Col 1, lines 55-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, and 5-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over James. James further discloses that each arm is generally rectangular and the corners of the arms distant from the base may be chamfered (Col. 2, lines 15-18), the layer wrap being a foam padding material, wherein a thin sheet of leather like material is disposed on the surface of one arm's facing the other arm

James discloses the claimed invention except for the limitations of the plastic being acrylic and the wrap being neoprene, the channel being about 8-12 inches long, wherein the thin sheet is rubber, wherein the arms measures about 2 ½ outward from the base, wherein the front elevation of the slot is about 1 ¾ inches and the elevation of the slot at the base is about 2 inches, wherein the rubber sheet is from 1/32 to 1/16 inches thick, and wherein the front elevation of the slot is about ¾ inches and the elevation of the slot at the base is about 7/8 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the materials of the channel, the wrap layer, and the thin sheet to have been acrylic,

Art Unit: 3632

neoprene, and rubber for the purpose of providing the device with an alternative clear rigid plastic channel and an inexpensive synthetic rubber padding and thin sheet, since it would have been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

It would have been an obvious matter of design choice to have modified the dimensions of the channel in James to have been the specified dimensions cited by the applicant, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 1,417,325 to Hopp et al.

U.S. Patent 1,878,850 to Hilgers

U.S. Patent 2,704,409 to Randall

U.S. Patent 3,300,250 to Dollgener et al.

U.S. Patent 4,089,497 to Miller et al.

U.S. Patent 4,368,912 to Holtz

U.S. Patent 4,703,531 to Bissett

U.S. Patent D316,535 to Fenn


U.S. Patent 5,848,772 to Fitzgerald

U.S. Patent 5,231,739 to Mattesky

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (703) 308-2162. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anita M. King
Primary Examiner
Art Unit 3632

September 27, 2004